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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91237315
Party	Defendant Universal Life Church Monastery Storehouse, Inc.
Correspondence Address	MICHAEL P MATESKY II MATESKY LAW PLLC 1001 4TH AVE, SUITE 3200 SEATTLE, WA 98154 UNITED STATES trademarks@mateskylaw.com, mike@mateskylaw.com 206-701-0331
Submission	Opposition/Response to Motion
Filer's Name	Michael P. Matesky, II
Filer's email	mike@mateskylaw.com, litigation@mateskylaw.com, amy@agilelegal.com
Signature	/aw for Mike Matesky/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE
MINISTRIES,
Opposer,

v.

UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE, INC.
Applicant.

Opposition No. 91237315

MOTION TO RE-OPEN DISCOVERY
TO RESPOND TO MOTION FOR
PARTIAL SUMMARY JUDGMENT

Pursuant to Fed. R. Civ. P. 6(b) and 56(d), 37 C.F.R. § 2.127(e)(1), and T.B.M.P. §§ 509.01(b)(1) and 528.06, Applicant Universal Life Church Monastery Storehouse (“Applicant”) moves to re-open the discovery period and for leave to take additional discovery in order to respond to Opposer’s motion for partial summary judgment. More specifically, Applicant seeks leave to serve five additional requests for production of documents, to serve five additional interrogatories, and to depose Opposer and each individual that sent or received any of Opposer’s late-produced documents for a total of no more than eight hours of combined deposition record time.

Opposer withheld relevant, responsive documents during the discovery period, and produced such documents long after the close of discovery — approximately two weeks before filing its motion for partial summary judgment. These late-produced documents are confusing, lack context, and do not appear to have been produced in the manner kept in the ordinary course of business. The late-produced documents are directly relevant to factual claims relied upon in Opposer’s motion for partial summary judgment, namely, the manner in which Opposer and third-parties use the term “get ordained.” Because Applicant cannot effectively rebut Opposer’s factual claims without further discovery regarding Opposer’s late-produced documents, because Opposer should not be rewarded for its failure to comply with its discovery obligations, and because Opposer stipulated that timing would not be a bar to any request for additional discovery, Applicant requests that the Board re-open

the discovery period and grant Applicant leave to take limited additional discovery in order to respond to Opposer's motion for partial summary judgment.

I. BACKGROUND

Discovery closed in this matter on November 16, 2018. (Order, Dkt. No. 13, at 5.) However, the Board extended the discovery period until January 25, 2019, for the sole purpose of taking previously-noticed depositions. (Order, Dkt. No. 20.) On January 25, 2019, Applicant's counsel took the combined 30(b)(6) deposition of AMM and personal deposition of Dylan Wall, Opposer's former Executive Director. (Matesky Decl., submitted concurrently herewith, ¶ 3.) During this deposition, Applicant learned that Opposer regularly uses the Slack and Pivotal Tracker platforms for internal communications but had not searched such platforms for any documents responsive to Applicant's discovery requests or produced any such responsive documents. (Matesky Decl. ¶¶ 3-4, Ex. A at 94:8-16.)

Because Opposer's discovery violation was discovered on the last day of the limited extended discovery period, the parties stipulated that (a) Opposer would search its Slack and Pivotal Tracker communications platforms and produce responsive documents by February 8, 2019, (b) the parties would meet and confer regarding any deficiencies in such production, and (c) the timing of any motion to compel or for leave to take additional discovery would not bar relief. (*Id.* ¶¶ 3, 5, Ex. A at 188:23-189:19.)

Opposer did not produce additional responses by February 8, as agreed, but did provide additional responses and responsive documents on February 11, 2018. (*Id.* ¶¶ 6-7.) These late-produced documents included a 3-page spreadsheet purportedly showing correspondence via the Pivotal Tracker platform, and 10 pages apparently showing individual messages sent through the Slack platform. (*Id.* ¶¶ 7-9, Exs. B-C.) All of the late-produced documents relate to Opposer's use of the phrase "get ordained" in one form or another. (*See id.*)

The Slack communications platform allows multiple users to send real-time communications with each other through particular channels, like a chatroom or message board. Each user with access to a particular channel can see each communication sent through that channel in chronological order (*See id.* ¶¶ 10-12, Ex. D; *What is Slack?* available at <https://www.youtube.com/watch?v=9RJZMSsH7-g> at :15-:45.) Thus, in the #NewProject channel,

a user may send the message “Monday” in response to a prior user’s message “When is the project due?” Similarly, a user can also send a direct message to another specified user or group of users, which will be visible only to those designated recipients. (*See id.*; *What is Slack?* at 1:10-1:25.)

Opposer’s late-produced Slack messages are almost exclusively individual messages divorced from the channel in which they were sent or any other conversation or context within the Slack messaging platform. It is not clear from the documents produced by Opposer who had access to these messages, or, in some cases, who sent these messages. (*See* Matesky Decl. ¶¶ 8, 14, 25, Ex. B.) When compared to Slack promotional videos and example screen shots showing use of the Slack messaging platform, it appears that the Slack messages produced by Opposer were not produced in the manner in which they are ordinarily kept. (*Id.* ¶¶ 8, 12, 14, Exs. B, D.)

The late-produced Pivotal Tracker spreadsheet produced by Opposer contains information organized under the following headings: “Id,” “Title,” “Created at,” “Accepted at,” “Requested By,” “Description,” and “Comment.” (*Id.* ¶ 9, Ex. C.) However, the spreadsheet does not show who had access to the various “stories” summarized in the spreadsheet. (*Id.*) Moreover, when compared to actual screen captures showing the Pivotal Tracker platform in use, it is clear that the produced spreadsheet does not show these Pivotal Tracker stories as they are stored in the ordinary course of business. (*Id.* ¶¶ 9, 13, Exs. C, E.) The late-produced Slack and Pivotal Tracker documents both contain information that is redacted. (*Id.* ¶¶ 8-9, Exs. B-C.)

On February 18, 2019, Applicant’s counsel emailed Opposer’s counsel to identify deficiencies in Opposer’s late-produced documents. (*Id.* ¶ 15.) Opposer’s Counsel did not respond to this email. (*Id.* ¶ 16.) Applicant’s counsel followed up with a second email on February 28, 2019, before Opposer filed its motion for partial summary judgment, asking if counsel could meet and confer that day or the next day. (*Id.* ¶ 17.) Opposer requested that the parties meet and confer the following day and filed its motion for summary judgment that evening. (*Id.* ¶ 18; Dkt. No. 21.) Counsel for the parties telephonically met and conferred on Friday, March 1, 2019, and subsequently emailed further regarding the deficiencies in Opposer’s late-produced documents, but Opposer did not agree to any further production of documents or discovery. (Matesky Decl. ¶ 19.)

II. ARGUMENT

Applicant respectfully submits that the Board should allow Applicant to take further limited discovery related to Opposer's late-produced documents because (A) Applicant's inability to take discovery regarding the late-produced documents was due entirely to Opposer's actions, thereby establishing excusable neglect, (B) Applicant cannot effectively respond to Opposer's motion without additional discovery, and (C) denying additional discovery would effectively reward Opposer for discovery violations and procedural delay.

A. Legal Standards

A party seeking to re-open the time for taking discovery must show that its failure to act during the discovery period was the result of "excusable neglect." *See* Fed. R. Civ. P. 6(b); T.B.M.P. § 509.01(b)(1). A determination of whether a party has shown excusable neglect must take into account all relevant circumstances, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *See* T.B.M.P. § 509.01(b)(1) (citing *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993) and *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582 (T.T.A.B. 1997)).

"A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion." T.B.M.P. § 528.06; *see also* Fed. R. Civ. P. 56(d). "If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment." T.B.M.P. § 528.06.

B. Applicant's Inability to Take Discovery on Opposer's Late-Produced Documents Constitutes Excusable Neglect

Opposer did not produce its Slack and Pivotal Tracker documents until after the close of discovery, so Applicant could not possibly have taken discovery regarding such documents during

the discovery period. For this reason, Applicant's failure to take such discovery during the discovery period is the result of excusable neglect. "It has been held that the third *Pioneer* factor, i.e., 'the reason for the delay, including whether it was within the reasonable control of the movant,' may be deemed to be the most important of the *Pioneer* factors in a particular case." T.B.M.P. § 509.01(b)(1). In this case, the reason for the delay falls entirely on Opposer's shoulders. Opposer withheld responsive documents during the discovery period, and only produced them approximately two weeks prior to filing its motion for partial summary judgment. (Matesky Decl. ¶¶ 4-7, 18.) It was therefore impossible for Applicant to take discovery regarding such documents during the discovery period, and the reason for delay was not "within the reasonable control of the movant."

The other *Pioneer* factors also weigh in favor of finding excusable neglect. Applicant has acted in good faith in trying to resolve this discovery issue, both by stipulating with Opposer on a procedure to produce and review Opposer's previously-withheld documents, and by attempting to meet and confer with Opposer's counsel to resolve the parties' dispute. (*Id.* ¶¶ 5, 15-19.) Similarly, any prejudice to Opposer or delay caused by re-opening discovery is entirely the result of Opposer's own actions and should not be held against Applicant (or used as justification to reward Opposer for its failure to comply with discovery obligations). Thus, because all relevant factors weigh in favor of finding excusable neglect, Applicant submits that the Board should allow Applicant to take limited additional discovery related to Opposer's late-produced documents.¹

C. Applicant Cannot Effectively Respond to Opposer's Partial Summary Judgment Motion Without Additional Discovery

Applicant cannot effectively respond to Opposer's partial summary judgment motion without limited additional discovery regarding Opposer's late-produced documents, because (1) Opposer relies on factual claims regarding Opposer's and third-parties' use of the term "get ordained," and (2) Opposer's late-produced documents throw such claims and allegedly supporting evidence into question. If a party seeking additional discovery to oppose a summary judgment motion can demonstrate "a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely

¹ Notably, because Opposer seeks only partial summary judgment (Dkt. No. 21), Applicant's request to re-open discovery stands independent of Applicant's request for discovery to respond to Opposer's motion for partial summary judgment.

within the control of the party moving for summary judgment.” T.B.M.P. § 528.06. Opposer’s motion for summary judgment relies on factual claims regarding use of the term “get ordained” by Opposer and third parties. However, Opposer’s last-minute document production suggests that Opposer’s use of the term “get ordained” was engineered in order to bolster its legal theory and that Opposer coordinated with third parties to do the same. Applicant cannot effectively rebut Opposer’s claims regarding use of the term “get ordained” without additional discovery on this topic.

The alleged use of the term “get ordained” by Opposer and third parties is a central issue in this proceeding. Opposer argues in support of its motion for partial summary judgment that “ULC, AMM, and their competitors all offer services to people to ‘get ordained’” and that they “have an interest in communicating their services to potential customers seeking to get ordained with generic and natural terminology.” (Opp.’s Mot., Dkt. No. 21, at 5, 7.) In support of its argument, Opposer relies upon third-party websites purporting to demonstrate how the term “get ordained” is used by third parties. (*Id.* at 7; Stephens Decl., Dkt. No. 21, at Ex. F.)

However, Opposer’s late-produced documents suggest that use of the term “get ordained” is not simply “generic and natural terminology,” but that Opposer consciously engaged in uses of the term “get ordained” for the sole purposes of supporting its legal theory. (Matesky Decl. ¶¶ 20-21.) For example, in one of the late-produced Slack messages, Opposer’s Executive Director Lewis King writes “what if we said ‘Get Ordained’” on November 1, 2018, well after this Opposition was initiated. (*Id.* ¶ 8, Ex. B at AMM000790.) Opposer produced this message completely divorced of any context, and Applicant has not yet been allowed to depose Opposer or Mr. King regarding the nature of this message. (*Id.* ¶¶ 8, 25, Ex. B at AMM000790.) However, the message appears to indicate that Mr. King sought to artificially inflate Opposer’s use of the term “get ordained” after this legal dispute arose in order to support the claim that it is a necessary or common term. (*Id.* ¶¶ 8, 20-21, Ex. B. AMM000790.) Indeed, Opposer’s own evidence shows that it had previously used the terms “Become a Minister” and “Apply for Ordination” as natural terminology. (Stephens Decl., Dkt. No. 21, Ex. F at AMM000682-83.)

Similarly, Opposer’s late-produced documents suggest that Opposer coordinated with third-parties regarding the language used in reference to ordination services. (*Id.* ¶¶ 8-9, 22-24, Ex. B at AMM000784-85, Ex. C at AMM000792.) In one of the late-produced Slack messages, a user named Natasha (presumably Opposer’s marketing employee Natasha Anakotta) says “IT’S

ALLIIIIIIIIIVE” in reference to an article on OffBeatBride.com that includes the following language: “‘Will you marry us?’ Here’s the VIP way to ask your friend to be your wedding officiant (and get ordained!).” (*Id.* ¶ 8, Ex. B at AMM000785.) This message was posted to Opposer’s #WYMU (i.e., “Will You Marry Us”) Slack channel. (*Id.*) The late-produced Pivotal Tracker spreadsheet and another late-produced Slack message also refer to coordinating language between third-party sites and Opposer’s own “WYMU landing page.” (*Id.* ¶¶ 8-9, 22-24, Ex. B at AMM000784, Ex. C at AMM000792.) For example, these messages refer to language published at *The Knot*, which is a third-party website that Opposer cites in support of its motion for partial summary judgment as an example of how third-parties use the term “get ordained.” (*Id.*; Stephens Decl., Dkt. No. 21, Ex. F at AMM000374.)

Again, Opposer produced these messages completely divorced of any context (e.g., without any prior or subsequent messages posted to the relevant Slack channel), and Applicant has not yet been allowed to depose Ms. Anakotta, Lewis King, or Opposer regarding the nature of these messages. (*Id.* ¶¶ 8-9, 25, Exs. B-C.) However, these message appear to indicate that Opposer coordinated with third parties regarding language used to refer to ordination services—including the very third parties that Opposer cites as examples of how the term “get ordained” is used in the relevant market.² (*Id.* ¶¶ 8-9, 22-24, Ex. B at AMM000784-85, Ex. C at AMM000792.)

As discussed above, the use of the term “get ordained” by Opposer and third-parties is a central issue in this proceeding, and a central basis for Opposer’s partial summary judgment motion. If the evidence and claims on which Opposer relies are actually the result of Opposer’s conscious manipulation and influence, for the purpose of supporting its legal claims, it would significantly undermine the validity of such evidence and claims. If Opposer had produced these documents in a timely fashion, Applicant would have followed up with additional document requests, interrogatories, and deposition questioning during the discovery period to resolve these key factual questions. (*Id.* ¶ 26.) However, because Opposer waited until after the close of discovery, Applicant is now in need of evidence and information that remain exclusively in Opposer’s control in order to resolve this key factual question and to effectively respond to Opposer’s partial summary judgment motion. (*Id.* ¶¶ 25, 27.)

² Significantly, Opposer has not cited to any third-party websites demonstrating use of the term “get ordained” in prior to initiation of this Opposition proceeding.

This is precisely the type of situation in which the Board has authorized additional discovery. *See, e.g. CBB Grp., Inc. v. Trademark Tools Inc.*, Order, No. 92063979 at 3 (T.T.A.B. Aug. 7, 2017) (attached to the Matesky Decl. as Ex. F). In *CBB Group*, the Respondent had already served discovery requests on the Petitioner and discovery had closed. However, the Board allowed the Respondent to take additional discovery in order to oppose summary judgment where it “set forth specific issues of fact on which it asserts it needs information which is in Petitioner’s control” and such issues were “central issues to this proceeding.” *Id.*

Similarly, in *Opryland USA Inc. v. The Great Am. Music Show, Inc.*, the Federal Circuit reversed the Board’s refusal to allow additional discovery prior to resolution of a summary judgment motion. 970 F.2d 847, 852 (Fed. Cir. 1992). In that case, the petitioner Opryland sought discovery related to the public perception of the term “opry” in order to oppose a motion for summary judgment filed by the respondent Great American Music Show. The Federal Circuit held that Opryland “cannot be deprived of the discovery needed to place at issue material factual questions in opposition to the motion” and that the “evidence [regarding public perception of the term “Opry”] sought by Opryland is directly related to the principal issues raised by Great American for summary adjudication.” *Id.* This is analogous to this case, where Applicant seeks evidence directly related to the alleged public use of “get ordained,” on which Opposer relies, which is a central issue to this case. Accordingly, Applicant requests that the Board allow Applicant to take limited additional discovery in order for Applicant to oppose the summary judgment motion filed by Opposer.

D. The Board Should Not Reward Opposer For Discovery Violations and Procedural Delay

The Board should grant Applicant leave to take limited additional discovery because to do otherwise would reward Applicant for discovery violations and procedural delay. It is undisputed that Opposer failed to search its communications platforms and failed to produce responsive documents during the discovery period. (*Id.* ¶¶ 3-4, Ex. A at 94:8-16.) When Opposer admitted this fact in deposition testimony, the parties stipulated that Opposer would search its communications platforms, provide responsive documents, that the parties would meet and confer regarding any disputes, and that if Applicant brought any motion regarding discovery, the timing of such motion

would not bar relief. (*Id.* ¶¶ 3-5, Ex. A. at 188:23-189:19.) However, Opposer has worked to undermine this stipulation and benefit from its delay.

First, Opposer failed to produce documents on the stipulated date. (*Id.* ¶¶ 6-7.) Second, Opposer produced documents in cryptic form, divorced from context, and not in the form ordinarily kept. (*Id.* ¶¶ 8-9, 12-14, 25, Exs. B-E.) Third, when Applicant's counsel reached out to discuss the deficiencies in Opposer's late-produced documents, Opposer ignored counsel's email. (*Id.* ¶¶ 15-16.) Fourth, when Applicant's counsel followed up to set a time to discuss Opposer's late production, Opposer delayed that discussion until after it filed its summary judgment motion. (*Id.* ¶¶ 17-18.) In light of Opposer's violation of its obligations during the discovery period, delayed production of deficient documents after the discovery period, and continued delays in addressing the deficiencies in its late-produced documents, it would be inequitable for the Board to reward Opposer by foreclosing further discovery regarding Opposer's late produced documents.

III. CONCLUSION

For the reasons stated above, Applicant respectfully requests that the Board grant its motion for limited additional discovery, and grant leave for Applicant to (1) serve five additional requests for production of documents on Opposer, (2) serve five additional interrogatories on Opposer, and (3) depose Opposer and each individual who sent or received any communication identified in Opposer's late-produced documents, for a total of no more than 8 hours of deposition time.

DATED: April 1, 2019

Respectfully submitted:

MATESKY LAW^{PLLC}

s/ Michael P. Matesky, II/
Michael P. Matesky, II
(Washington Bar No. 39586)
1001 4th Ave., Suite 3200
Seattle, WA 98154
Ph: 206.701.0331
Fax: 206.702.0332
Email: mike@mateskylaw.com;
litigation@mateskylaw.com

Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing Motion to Re-Open Discovery to Respond to Motion for Partial Summary Judgment, and the supporting Declaration of Michael P. Matesky, II and exhibits thereto, on Opposer's counsel of record by email transmission to nancy.stephens@foster.com, pursuant to Trademark Rule §2.119(b), 37 C.F.R. §2.119(b).

Dated: April 1, 2019

s/ Amy Wallace/
Amy Wallace

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE, INC.

Applicant.

Opposition No. 91237315

DECLARATION OF
MICHAEL P. MATESKY, II

I, Michael P. Matesky, II, declare as follows:

1. I am over 18 years of age and competent to testify in this matter.
2. I am and at all relevant times have been counsel for Applicant in this matter.
3. On January 25, 2019, I took the combined 30(b)(6) deposition of American Marriage Ministries and personal deposition of Dylan Wall. True and correct excerpts of the transcript of this deposition are attached hereto as Exhibit A.
4. During the combined Wall and American Marriage Ministries deposition, I learned that American Marriage Ministries had not searched the Slack or Pivotal Tracker communications platforms that it uses for documents responsive to Applicant's previously-served discovery requests.
5. In response to this discovery, Applicant and Opposer stipulated on the deposition record that (a) Opposer would search its Slack and Pivotal Tracker communications platforms for responsive documents and produce such documents to Applicant by February 8, 2019, (b) counsel for the parties would meet and confer to resolve any disputes regarding such production prior to seeking relief from the Board, and (c) the timing of any motion seeking such discovery relief from the Board would not be a bar to relief.
6. Opposer did not produce additional discovery responses by February 8, 2019.
7. Opposer produced additional Slack messages and a spreadsheet purporting to identify Pivotal Tracker communications on February 11, 2018.

8. True and correct copies of the Slack messages produced by Opposer on February 11, 2018 are attached hereto as Exhibit B.

9. A true and correct copy of the spreadsheet purporting to identify Pivotal Tracker communications produced by Opposer is attached hereto as Exhibit C.

10. As of the date of my signature below, a video explaining the features and functionality of the Slack communications platform is available online via the Slack YouTube channel at <https://www.youtube.com/watch?v=9RJZMSsH7-g> (the “*What is Slack?* Video”).

11. The narrator in the *What is Slack?* Video states that team conversations are organized into channels, messages posted to public channels can be viewed by all team members, messages posted to private channels can be viewed by team members with permission, and direct messages can also be sent to specifically identified individuals.

12. True and correct screen captures of the *What is Slack?* Video showing the Slack communications platform in use are attached hereto as Exhibit D.

13. A true and correct copy of an image from the PivotalTracker.com website showing the Pivotal Tracker communications platform in use is attached hereto as Exhibit E.

14. After reviewing the Slack and Pivotal Tracker documents produced by Opposer, I am unable to determine who received or perceived the communications disclosed therein, in some cases who sent such communications, and the context in which such communications were sent or received.

15. On February 18, 2019, I sent an email to three attorneys and two paralegals/assistants representing Opposer in this matter identifying deficiencies in Opposer’s Slack and Pivotal Tracker documents and suggesting that we meet and confer to resolve such deficiencies.

16. I did not receive a response to my email of February 18, 2019.

17. I sent a follow-up email to Opposer’s counsel on February 28, 2019, before Opposer had filed its motion for partial summary judgment, seeking to meet and confer regarding the deficiencies in Opposer’s Slack and Pivotal Tracker documents.

18. Opposer’s counsel requested that we meet and confer the following day, and subsequently filed a motion for partial summary judgment on February 28, 2019, prior to our scheduled conference.

19. I telephonically met and conferred with Opposer's counsel on Friday, March 1, 2019, regarding deficiencies in Opposer's Slack and Pivotal Tracker documents. I subsequently emailed further with Opposer's counsel, but Opposer was unwilling to produce any additional documents or consent to further discovery.

20. The Slack and Pivotal Tracker documents produced by Opposer suggest that Opposer purposefully engaged in use of the term "get ordained" after the start of this Opposition proceeding in order to create evidence that would support its legal argument.

21. At least one Slack message appears to show Opposer's Executive Director Lewis King suggesting that Opposer use the term "get ordained" instead of an alternative term, well after the start of this Opposition proceeding.

22. The Slack and Pivotal Tracker documents produced by Opposer suggest that Opposer coordinated with third party website operators regarding the language used to refer to Opposer's services, including third party websites that Opposer cites as evidence in support of its partial summary judgment motion, and including regarding use of the term "get ordained." order to create evidence that would support its legal argument.

23. At least one Slack message appears to show Opposer's marketing employee coordinating with the operator of the Off Beat Bride website regarding commentary on Opposer's website that includes the language "get ordained."

24. At least one Slack message and one Pivotal Tracker message appears to show Opposer coordinating with multiple third parties regarding language used to refer to Opposer, including a third-party website that Opposer cites in support of its partial summary judgment motion.

25. The partial and cryptic nature of the Slack and Pivotal Tracker messages produced by Opposer, which do not show any context of the channel or direct messaging conversation within which they were sent, and do not show who received or had access to such message, make it necessary to obtain further documents, interrogatory responses, and deposition testimony in order to fully understand the meaning of such documents.

26. If Opposer had produced the Slack and Pivotal Tracker documents attached hereto as Exhibits B and C during the discovery period, Applicant would have following up with additional document requests, interrogatories, and deposition questioning regarding the nature, context, and meaning of such documents and correspondence.

27. Applicant cannot effectively respond to Opposer's motion for partial summary judgment without further discovery regarding the Slack and Pivotal Tracker documents produced by Opposer.

28. Attached hereto as Exhibit F is a true and correct copy of an order entered by the Board on August 7, 2017, in *CBB Grp., Inc. v. Trademark Tools Inc.*, Cancellation No. 92063979.

DATED: April 1, 2019

s/ Michael P. Matesky, II/

Michael P. Matesky, II

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE)	
MINISTRIES,)	
Opposer,)	
vs.)	Opposition No. 91237315
UNIVERSAL LIFE CHURCH)	
MONASTERY STOREHOUSE,)	
INC.,)	
Applicant.)	

30 (B) (6) DEPOSITION UPON ORAL EXAMINATION OF
AMERICAN MARRIAGE MINISTRIES
DESIGNEE: DYLAN JAMES WALL
COMBINED WITH
PERSONAL DEPOSITION UPON ORAL EXAMINATION OF
DYLAN JAMES WALL

9:30 a.m.

January 25, 2019

600 University Street, Suite 320

Seattle, Washington

REPORTED BY: Brenda Steinman, CCR #2717

1 Q. (By Mr. Matesky) Back on the record.
2 Who was primarily responsible for
3 searching for documents to produce in discovery in
4 this matter?

5 A. I searched my email. Glen searched
6 his. And I guess I was the one who forwarded that
7 to Nancy.

8 Q. Did AMM search Slack messages to
9 produce in discovery?

10 A. Not that I know of.

11 Q. Did AMM search Pivotal trader
12 messages to produce in discovery?

13 A. I'm assuming you mean Pivotal
14 Tracker.

15 Q. Sorry.

16 A. And no, not that I'm aware of.

17 I also don't know that either was in
18 use when we were initially producing documentation.

19 Q. Do you know when AMM personnel first
20 started using Slack for correspondence regarding
21 AMM business?

22 A. I believe it was maybe spring of
23 2018.

24 Q. And do you know when AMM personnel
25 first started using Pivotal Tracker for

1 A. No.

2 Q. Do you know which of the screenshots
3 represented in Exhibits 11 through 22 were created
4 by Natasha Anakotta?

5 A. Offhand I do not. Some of them --
6 some of them would have been either myself or her.
7 And if I was to refer back to my email and the
8 emails she sent me containing these screenshots, I
9 could tell you which ones she gathered.

10 MR. MATESKY: Applicant has no
11 further questions.

12 MS. MENNEMEIER: I have no further
13 questions.

14 (Recess 5:46 p.m. to 6:28 p.m.)

15 MR. MATESKY: We're back on the
16 record.

17 Counsel for the parties has conferred
18 and reached agreement on a couple issues; the first
19 of which is regarding conducting a further search
20 for responsive documents. And counsel for AMM can
21 explain the nature of that stipulation between the
22 parties.

23 MS. MENNEMEIER: Yes. AMM has agreed
24 that it will conduct a search of the Slack and the
25 Pivotal Tracker platforms in search of any

1 documents that might be responsive to requests for
2 production or interrogatories that have already
3 been issued in this matter.

4 AMM further agrees to produce any
5 responsive documents or supplemental interrogatory
6 responses within two weeks, in other words by
7 February 8.

8 Counsel for both parties has agreed
9 that they will engage in a meet and confer if
10 counsel for Applicant believe at that point that
11 there are any deficiencies in the supplemental
12 discovery responses.

13 If the parties cannot reach
14 resolution regarding any alleged deficiencies after
15 the meet and confer, the parties have agreed that
16 failure to timely file a discovery motion, in other
17 words failure to file a discovery motion until
18 after the meet and confer, will not be a bar to
19 relief on such motion.

20 MR. MATESKY: The second topic we
21 discussed is that the parties have agreed to go
22 back on the record to examine Mr. Wall regarding a
23 narrow topic, which is Applicant's requests for
24 Admission and Opposer's responses thereto.

25 ///

SEATTLE DEPOSITION REPORTERS, LLC
600 University Street, Suite 320
Seattle, Washington 98101
206.622.6661

C H A N G E S H E E T

PLEASE MAKE ALL CHANGES OR CORRECTIONS ON SHEET,
SHOWING PAGE, LINE AND REASON.

PAGE	LINE	CORRECTION AND REASON
------	------	-----------------------

40	11	"Chane" should be "Shane", misspelled.
----	----	--

146	20	Remove question mark, I do not believe my response was a question.
-----	----	--

151	18	"that's" should be "that", unless I misspoke.
-----	----	---


DYLAN WALL

Taken: Friday, January 25, 2019

Re: AMM v ULC Monastery
Opposition No. 91237315
Brenda Steinman, CCR.

1 S I G N A T U R E

2

3 I declare under penalty of perjury under
4 the laws of the State of Washington that I have
5 read my within deposition, and the same is true and
6 accurate, save and except for changes and/or
7 corrections, if any, as indicated by me on the
8 CHANGE SHEET flyleaf page hereof.

9 Signed in Seattle, Washington,
10 this 5 day of March, 2019.

11

12

13

DYLAN WALL

14

Taken: Friday, January 25, 2019

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23

24 Re: AMM v ULC Monastery
25 Opposition No. 91237315
Brenda Steinman, CCR.

EXHIBIT B

Lewis King – Oct 15th, 2018



Glen Yoshioka 11:23 AM

[Redacted text]

... Show more



[Redacted text]

Our Free Ordination Application takes less than a minute to become a legal marriage minister. Get ordained today so that you can perform marriage tomorrow. AMM is a 501c3 non-profit LGBTQ embracing ministry dedicated to ensuring your right to perform marriage. Get started now!

AMM000781

Lewis King - Oct 10th, 2018



Lewis King 1:17 PM

hey, is there a way to see what percentage of our sales are to non-ordained customers?



Glen Yoshioka 1:18 PM

Not conveniently



Lewis King 1:19 PM

folks are pushing to make it mandatory to get ordained before ordering anything...

AMM000782

Lewis King – Oct 8th, 2018 View in channel



Glen Yoshioka 5:36 PM



... Show more



Asked to Perform Marriage? Get ordained with AMM in minutes to become a legally ordained minister. We are an LGBTQ embracing 501c3 non-profit ...

AMM000783



pivotaltracker APP 11:13 AM

[AMM] lewis5 added comment with attachment: "Text for WYMU Reviews:

The Knot: "...a genius new way to propose to your officiant!"

Wedding Chicks: "American Marriage Ministries' "Will You Marry Us" gift package is oh-so-appropriate for couples looking to share the excitement and honor with their officiant.

Budget Savvy Bride: ...the best way to ask someone to officiate your wedding!"

Offbeat Bride: Here's the VIP way to ask your friend to be your wedding officiant (and get ordained!)

": [add WYMU reviews by media to the WYMU landing page](#)

AMM000784

#wymu - Jan 2nd



Natasha 9:45 AM

IT'S ALLIIIIIIIIIVE

<https://offbeatbride.com/how-to-ask-friend-officiant/> ... Show more



Offbeat Bride

"Will you marry us?" Here's the VIP way to ask your friend to be your wedding officiant (and get ordained!)

If you'll be having a friend of family member officiate your wedding (like I will be!), you'll definitely want to get introduced to this package ...

Jan 2nd



1 reaction

AMM000785

general – Dec 13th, 2018 View in channel



Lewis King 7:08 AM

<https://www.nytimes.com/2018/12/12/smarter-living/how-to-officiate-your-first-wedding-and-why-you-d-want-to.html> ... Show more

📰 The New York Times | By WHITSON GORDON

You can help a friend or loved one turn their special day into something remarkable, if you're willing — but getting ordained is the easy ...

AMM000786

Lewis King – Dec 7th, 2018



Lewis King 11:11 AM

we are, hard core, but if you get ordained now, you

AMM000787

general – Dec 4th, 2018



Colin Swenson-Healey 1:07 PM

Is this our official twitter? <https://twitter.com/ammofficials> ... Show more

 twitter.com

The latest Tweets from American Marriage Ministries (@ammofficials). Our mission is to guarantee that EVERYONE has the right to marry, to choose who solemnizes their marriage & to perform marriage. Get ordained for FREE today!.
Seattle, Washington

AMM000788

general – Nov 3rd, 2018



Lewis King 2:19 PM

<https://www.newsday.com/long-island/li-life/online-ordained-ministers-weddings-friends-family-1.22726199> ... Show more



Newsday

More Llers get ordained to marry family, friends

More couples are being married by friends and relatives who get ordained online for the event, sometimes because they aren't religiously ...

AMM000789

Lewis King – Nov 1st, 2018




Lewis King 4:34 PM

what if we said "Get Ordained"

AMM000790

EXHIBIT C

Id	Title	Created at	Accepted at	Requested By	Description	Comment
157612527	people getting re-ordained using the same email	5/15/2018	7/1/2018	Glen Yoshioka	<p>## NOTES</p> <ul style="list-style-type: none"> - Natasha has received emails where some people were able to get re-ordained using the same email. - It looks like this is happening because people can put in the same email with capitalization and it is recognized as a unique email. <p>## PROBLEM ACCOUNTS</p> <ul style="list-style-type: none"> - cassieterry1@hotmail.com 	
160530093	make the store submenu links anchor links in the store home	9/14/2018	9/15/2018	Glen Yoshioka	<ul style="list-style-type: none"> - Also fix the typo on the store home "Marriage other Ceremonial Certificates" to "Marriage & Ceremonial Certificates" - Also fix the styling for the get ordained and login buttons that replace the add to cart button on the product details page. 	
162453520	remove "american weddings" link from "wedding training" dropdown	12/5/2018	12/10/2018	lewis5	see titile	oh, also made the get ordained button on mobile a single line instead of two. (Glen Yoshioka - Dec 10, 2018)

163409363	add WYMU reviews by media to the WYMU landing page	1/22/2019		lewis5		<p>Text for WYMU Reviews:</p> <p>The Knot: "...a genius new way to propose to your officiant!"</p> <p>Wedding Chicks: "American Marriage Ministries' "Will You Marry Us" gift package is oh-so-appropriate for couples looking to share the excitement and honor with their officiant.</p> <p>Budget Savvy Bride: ...the best way to ask someone to officiate your wedding!"</p> <p>Offbeat Bride: Here's the VIP way to ask your friend to be your wedding officiant (and get ordained!)</p> <p>(lewis5 - Jan 27, 2019)</p>
160867248	mop ordination cta optimization	9/28/2018		Glen Yoshioka	<p>- if landing on the ordination page from the mop ordination cta, there should be content at the top of the ordination form that tells people they need to get ordained before adding the product.</p> <p>- if the minister selects a state</p>	

					before clicking on the ordination button from the mop details page, the mop should remember that selected state when the minister lands back on the mop. I don't know if that is already the behavior.	
--	--	--	--	--	--	--

EXHIBIT D

What is Slack?

The screenshot displays a Slack workspace window. On the left is a sidebar with a dark purple background. It contains a section for 'Acme Sites' with a user 'Julie Jefferson'. Below this is a 'CHANNELS (23)' section listing various channels: #accounting-comp, #engineering, #engineering-hiring, #general, #marketing (highlighted in green), #nyc, #project-mobile, #project-nano, #random, #sales, #sales-reviews, #tweet-feed, and #watercooler. At the bottom of the sidebar is a 'DIRECT MESSAGES (14)' section listing conversations with slackbot, Candace, and a group chat with Isaak, Jenny, Lisa, Roberto, Seb, Stephanie, and Yann.

The main area of the window shows the '#marketing' channel. At the top right of this area, it indicates 18 members and a search bar. The conversation history includes:

- Noemie** (1:21 PM): We'll need to revise the inbound marketing plan to include new clients.
- Seb** (1:21 PM): No problem. The only thing I need is the updated client list with our NYC customers.
- Isaak** (3:53 PM): I don't have any of their information. Maybe we can get @roberto to ask them?
- Roberto** (3:54 PM): You ask, you shall receive:
Uploaded a file *

A file upload card is shown below Roberto's message, displaying a Google Drive icon, the filename 'Customer List - Full', the size '456KB', and the source 'Document from Google Drive'. It includes icons for download, open, and comment.

The conversation continues with:

- Isaak** (3:58 PM): Roberto = Employee of the Month
- Roberto** (4:10 PM): 😊
- Lisa** (4:18 PM): Remember, meeting at 10:30 in the conference room.
- Isaak** (4:20 PM): Yep, no problem. I'll be all over it after we're done. 👍
- Julie** (4:22 PM): Oh, that's right! Thanks for the reminder. I keep thinking today is Tuesday for some reason.

At the bottom of the channel view is a text input field with a plus icon on the left and a speech bubble icon on the right.



0:05 / 2:36



What is Slack?

Slack

Acme Sites

Julie Jefferson

CHANNELS (23)

accounting-comp

engineering

engineering-hiring

general

marketing

nyc

project-mobile

project-nano

random

sales

sales-reviews

tweet-feed

watercooler

DIRECT MESSAGES (14)

slackbot

Candace

Isaak, Jenny, Lisa, ...

Roberto

Seb

Stephanie

Yann

#marketing

18

Search



Isaak 4:20 PM

Yep, no problem. I'll be all over it after we're done. 🙌



Julie 4:22 PM

Oh, that's right! Thanks for the reminder. I keep thinking today is Tuesday for some reason.

That's what I get for skipping my coffee! ☕



Isaak 4:24 PM

Will @doug be making one of his famous uber-awesome presentations?



Isaak 4:24 PM

[Presentation-Winner.jpg](#)



1MB JPG in #marketing • [Add comment](#) • [Open original](#)



Doug 4:25 PM

Prepare to be amazed @isaak.



0:10 / 2:36



What is Slack?

Acme Sites

Julie Jefferson

CHANNELS (23)

accounting-comp

engineering

engineering-hiring

general

marketing

nyc

project-mobile

project-nano

random

sales

sales-reviews

tweet-feed

watercooler

#nyc



Noemie 1:22 PM

Great, thanks



Seb 1:34 PM

This is our current proposal.

Shared a file



Proposal NY Office Team.docx

58KB Document from Google Drive



Lauren 2:12 PM

Just met with the developers.



Roberto 2:12 PM

Oh, how did it go?



Lauren 2:13 PM

We ROCKED it! All we need now is to put together a statement of work



Isaak 2:13 PM



0:25 / 2:36



EXHIBIT E

My Sample Project 2

36

Search project

HELP & UPDATES

NATHANSWAIN1

Current Velocity

Done

1

8

+

Add Story

My Work

2

Current

Backlog

Icebox

Done

Epics

Labels

Charts

Project History

26 Jan

Pts: 5

TS

Setup development environment

Setup demo server

deployment

Admin should be able to login

admin

Admin should be able to create new product

admin

Admin should be able to upload product photo

admin

2 Feb

Pts: 11

TS

Admin should be able to upload multiple product photos and mark one as the primary

admin

Shopper should see list of products, with primary photo as thumbnail

shopping

Product browsing should be paginated, with 10 products per page

shopping

Make product browsing pagination AJAXy

shopping, usability

Admin should be able to import multiple new products from CSV file

admin

9 Feb - Current

Pts: 2 of 7

TS

Hide accepted stories

Shopper should be able to click on a product, and see all product details, including photos

shopping

Shopper should be able to add product to shopping cart

cart, shopping

Shopper should be able to view contents of shopping cart

cart, shopping

Accept

Reject

Shopper should be able to remove product from shopping cart

cart, shopping

Accept

Reject

Cart manipulation should be AJAXy

cart, shopping

Deliver

Some product photos not scaled properly when browsing products

shopping

Finish

Shopper should be able to recommend a product to a friend

shopping

Start

configure solr for full text searching

search

Start

16 Feb

Pts: 9

TS

Shopper should be able to search for product

search, shopping

Start

Initial demo to investors

Finish

Shopper should be able to enter credit card information and shipping address

checkout, shopping

Start

Integrate with payment gateway

checkout, shopping

Start

When shopper submits order, authorize total product amount from payment gateway

checkout, needs discussion, shopping

Start

If system fails to authorize payment amount, display error message to shopper

checkout, shopping

Start

If authorization is successful, show order number and confirmation message to shopper

checkout, shopping

Start

23 Feb

Pts: 8

TS

Send notification email of order placement to admin

admin, checkout, shopping

Start

Shopper should be able to check status of order by entering name and order number

orders

Start

Shopper should be able to ask question about order

orders

Start

Admin can review all order questions and send responses to shoppers

admin, orders

Start

Set up Engine Yard production

Start

Icebox

Product browsing pagination not working in IE6

le6

Start

Integrate with automated order fulfillment system

Start

native iPhone app to allow product browsing and checkout

epic

Start

Facebook app, allowing users to share favorite products

Start

Fixed

|||

+

+

EXHIBIT F

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: August 7, 2017

Cancellation No. 92063979

CBB Group, Inc.

v.

Trademark Tools Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes before the Board on Respondent's motion for 56(d) discovery filed in lieu of a response to Petitioner's motion for summary judgment on the basis of likelihood of confusion. 8 TTABVUE; 11 TTABVUE. The motion for 56(d) discovery is contested by Petitioner.¹

In order to establish that it is entitled to discovery under Fed. R. Civ. P. 56(d), a party must show through affidavit or declaration "reasons why discovery is needed in order to support its opposition" to applicant's motion for summary judgment. *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 852, 23 USPQ2d 1471, 1474 (Fed Cir. 1992) (citing *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989)). A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may

¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

file a request with the Board for time to take the needed discovery. *See id.*; *see also Celotex v. Catrett*, 477 U.S. 317, 326 (1987) ([Rule 56(d)] provides nonmovants with protection from being “railroaded” by premature summary judgment motions). The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion. *See Fed. R. Civ. P. 56(d); Opryland USA Inc.*, 23 USPQ2d at 1475. It is not sufficient that a nonmovant simply state in an affidavit that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present by affidavit facts sufficient to show the existence of a genuine dispute of material fact for trial. *See TBMP § 528.06* and cases cited therein. If a party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment. The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment. *See Fed. R. Civ. P. 56(d); TBMP § 528.06; Opryland USA Inc.*, 23 USPQ2d 1471; *Murray Bakery Products*, 9 USPQ2d 1736.

Respondent, supported by a declaration of its attorney, argues that it needs to depose Raymond Hung, Petitioner’s founder and president, who provided a declaration in support of Petitioner’s motion for summary judgment. Respondent argues that it needs additional discovery to rebut the statements made in the Hung declaration; that

the Hung declaration “includes new facts previously undisclosed to [Respondent]”; that the Hung declaration “purports to explain discrepancies among the dates and locations, and to create the missing link between dates and places of alleged sales and Petitioner’s use of the TOOL MASTER brand in association with those sales”; that Petitioner’s use of its mark is a “central issue in this proceeding”; and that it seeks to “cross-examine Mr. Hung on the evidence presented in the Hung Declaration ... including Petitioner’s alleged dates of first use ..., the geographic locations relating to same, and the products and packaging that are the subject of such allegations.” 11 TTABVUE 2-4, 108. In short, Respondent argues that it needs additional discovery regarding Petitioner’s dates of first use and alleged priority.²

Discovery has closed in this proceeding and Respondent has already served Petitioner with document requests and interrogatories. Notwithstanding the foregoing, considering the circumstances of this proceeding and the parties’ arguments and submissions, Respondent, as the nonmoving party, has set forth specific issues of fact on which it asserts it needs information which is in Petitioner’s control, namely, Petitioner’s claim of priority based on common law use of its mark as asserted by Mr. Hung. Petitioner’s common law use and priority are central issues to this proceeding

² Respondent also argues that “Petitioner’s answer to prior discovery provided some information about sales of goods, but did not establish the dates, scope and geography of Petitioner’s use of the TOOL MASTER mark *per se* in those sales.” 11 TTABVUE 4. To the extent Respondent is attempting to compel responses to its written discovery under the guise of a motion for Rule 56(d) discovery, the Board finds such an attempt to be procedurally improper. A Rule 56(d) motion is limited in purpose, namely, a vehicle for obtaining discovery necessary to respond to a motion for summary judgment. *See, e.g., Keebler Co. v. Murray Bakery Products*, 9 USPQ2d 1736 (Fed. Cir. 1989).

and Respondent is entitled to discovery thereon prior to responding to the motion for summary judgment. *See, e.g., Orion Grp. Inc. v. The Orion Insur. Co. P.L.C.*, 12 USPQ2d 1923, 1924-25 (TTAB 1989).

In view of these findings, the motion for discovery under Fed. R. Civ. P. 56(d) is **granted** as noted herein. Respondent is allowed until **September 10, 2017** to depose Mr. Hung only, at a mutually agreeable date and time.³ However, because the issues raised in relation to Petitioner's likelihood of confusion allegations are largely questions of fact that are resolved based largely or solely on objective factors – *e.g.*, similarity or dissimilarity of the parties' marks and goods, the deposition of Mr. Hung is limited to the topics discussed in his declaration made in support of Petitioner's motion for summary judgment, namely 1) allegations regarding Petitioner's dates of use and priority, 2) the geographic locations regarding the allegations of Petitioner's dates of use and priority, and 3) the products and packaging related to those allegations of Petitioner's dates of use and priority.

The Board resets briefing for the motion for summary judgment based on likelihood of confusion. Respondent's brief in response to the motion for summary judgment shall be due **October 20, 2017**. Petitioner's reply brief, if any, shall be due by operation of Trademark Rule 2.127(e)(1).

³ Should the parties require additional time to schedule Mr. Hung's deposition beyond the date set forth herein, the parties should so advise the Board. Should Respondent require additional time to obtain Mr. Hung's deposition transcript to submit with its response to summary judgment, it should so advise the Board.

Cancellation No. 92063979

Proceedings otherwise remain suspended pending disposition of Petitioner's motion for summary judgment.